

### **REMARKS/ARGUMENTS**

Prior to entry of this amendment, claims 1, 3, 7-16, 18-23 and 25-30 were pending in the application. No claims have been amended, added or canceled.. Therefore, after entry of this amendment, claims 1, 3, 7-16, 18-23 and 25-30 will remain pending for examination. Claims 1, 16 and 27-30 are independent claims.

#### **35 U.S.C. §101 Rejection, Non-statutory matter**

Claims 29 and 30 have been rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. These rejections are respectfully traversed.

The guidelines quoted (and emphasized) in the office action specifically state, "Since a computer program is merely a set of instructions capable of being executed by a computer . . . Office personnel should treat a claim for a computer program, without the computer readable medium needed to realized the computer program's functionality, as Non-statutory functional descriptive material." Office Action, at 4 (quoting MPEP § 2106.01) (emphasis added). However, the same guidelines continue, "When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim." *Id.* (quoting MPEP § 2106.01) (emphasis added).

Both claim 29 and claim 30 recite, inter alia, "[a] computer program, stored on a computer readable memory, for generating an electronic information disclosure statement ("IDS"), the computer program comprising a set of instructions executable by one or more processors in a server computer system" (emphasis added). It cannot reasonably be disputed that both claims 29 and 30 recite a computer program "in conjunction with a physical structure," which, as MPEP § 2106.01 confirms, renders each of those claims statutory (e.g., as product claims). Neither MPEP § 2106.01 nor any other authority of which undersigned counsel is aware requires the claim format proposed by the office action (that is, reciting that the computer program causes the computer to perform a series of steps, i.e., a method). Accordingly, the applicants respectfully request either the citation of some authority for the position taken by the office action, or the withdrawal of the rejections under § 101.

**35 U.S.C. § 103 Rejection, Rivette in view of Petruzzi in view of Tran**

Claims 1, 3, 7-16, 18-23 and 35-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over US 2003/0046307 to Rivette et al. (hereinafter "Rivette") in view of U. S. Patent No. 6,049,811 to Petruzzi et al. (hereinafter "Petruzzi") in view of US 2001/0049707 to Tran (hereinafter "Tran"). These rejections are respectfully traversed as well.

**1. Claim 1**

Consider, for example, claim 1, which recites, inter alia, "wherein the electronic document includes information corresponding to a plurality of fields in the electronic IDS, and wherein adding the IDS information to the electronic IDS comprises extracting the IDS information, via the automated process at the server system, from the electronic document and storing the IDS information, via the automated process and in a format specified by the official patent office, in a corresponding plurality of fields in the electronic IDS" (emphasis added).

- a) "[S]toring the IDS information, via the automated process and in a format specified by the official patent office, in a corresponding plurality of fields in the electronic IDS"**

Although the office action relies primarily on Rivette in rejecting claim 1, the office action correctly acknowledges that Rivette fails even to suggest the concept of an electronic IDS, let alone teaching the storage of IDS information in a plurality of fields in an electronic IDS. Instead, the office action contends that Petruzzi (specifically, col. 2, ll. 65-67 and col. 5, l. 48 – c. 6, l. 7) teaches these elements. Neither of the cited portions of Petruzzi provide any such teaching or suggestion, however.

The first passage of Petruzzi (col. 2, ll. 65-67) cited by the office action has nothing to do with electronic information disclosure statements; instead, that passage provides, as an object of Petruzzi's invention, "a method of analyzing and presenting an invention in the form appropriate for filing with the Patent and Trademark Office." Petruzzi, c. 2, ll. 65-67 (emphasis added). In other words, this passage pertains to the preparation of a patent application,

not an IDS (let alone an electronic IDS, as recited by claim 1). Hence, the first cited passage is inapposite for a variety of reasons.

The second cited passage (col. 5, l. 48 – c. 6, l. 7) of Petruzzi is no more helpful. While that portion of Petruzzi does at least contemplate the idea of an IDS, it merely teaches that that “the operator is prompted for references, a brief description of each reference, and the relevance of each reference with respect to the invention.” Petruzzi, c. 5, l. 67 – c. 6, l. 7 (emphasis added). Clearly, Petruzzi neither teaches nor suggests that any information might be incorporated with an automated process into an electronic IDS, but instead teaches the manual insertion of data into the form. This is a key difference between Petruzzi and the recited element of claim 1 – the manual insertion of data by a user, is a non-trivial difference from the recited incorporation of information by an automated process.

Tran fails to provide any of the disclosure missing from the combination of Rivette and Petruzzi. Thus, the invention recited by claim 1 is patentably distinct from the combination of Rivette, Petruzzi and Tran for at least these reasons.

**b) "[E]xtracting the IDS information, via the automated process at the server system, from the electronic document"**

The above deficiencies in Petruzzi's disclosure are highlighted when one considers the remainder of claim 1, which recites that the IDS information to be incorporated into the electronic IDS is "extract[ed] . . . , via the automated process at the server system, from the electronic document." The office action ignores this element in its entirety, and a review of the cited references (Rivette, Petruzzi and Tran) reveals no disclosure that might be read as teaching or suggesting this element.

For at least this additional reason, claim 1 is believed to be allowable over the combination of Rivette, Petruzzi and Tran, and reconsideration of that claim is respectfully requested.

**2. Claims 16 and 27-30**

The remaining independent claims, claims 16 and 27-30, each recite elements similar to those discussed above with respect to claim 1. Claims 16 and 27-30, therefore, are believed to be allowable over the combination of Rivette, Petruzzi and Tran for at least similar reasons.

**3. Claims 3, 7-15, 18-23, 25 and 26**

Claims 3 and 7-15 each ultimately depend from claim 1, while claims 18-23, 25 and 26 each ultimately depend from claim 16. These dependent claims are believed to be allowable at least by virtue of their dependence from allowable base claims.


**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

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Respectfully submitted,

  
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